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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/288,475 | 04/08/1999 | JOEL ZDEPSKI | OPTVP002 | 7545 |

7590 09/17/2002

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EXAMINER

VAUGHN JR, WILLIAM C

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| ART UNIT | PAPER NUMBER |
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2152

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/288,475

Applicant(s)

ZDEPSKI, JOEL

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This Action is in response to the latest communication received on 25 March 2002.
2. The application has been examined. **Claims 1-19** are pending. The objections and rejections cited are as stated below:

Information Disclosure Statement

3. The references listed in the Information Disclosure Statement submitted on 29 July 1999 have been considered by the examiner (see attached PTO-1449).

Drawings

4. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. The drawings are objected to because of the objections noted on the PTO-948 form attached. Correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 5 and 15** are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. Applicant's specification lacks the proper teachings that are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In claim 32, Applicant claims "*wherein the electronic message is unalterable by a user*" and in claim 14, *wherein the automatically generated reply message is unalterable by the user*". Applicant

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describes implicitly but not explicitly describes “*wherein the electronic message is unalterable by a user*” and in claim 14, wherein the automatically generated reply message is unalterable by the user”. Applicant only states on page 8 of the specification that “the proxy server sends the header to the set top box without additional formatting. Where within the specification does it describe, “*wherein the electronic message is unalterable by a user*” and in claim 14, wherein the automatically generated reply message is unalterable by the user”. It would require undue experimentation for one of ordinary skill in the networking art at the time the invention was made to determine how an electronic message is unalterable by a user” as well as how it the automatically generated reply message is unalterable by the user”.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noguchi et al. (Noguchi), U.S. Patent No. 6,163,345 in view of Hashimoto et al. (Hashimoto), U.S. Patent No. 5,931,905.

9. Regarding **claim 1**, Noguchi-Hashimoto discloses the invention substantially as claimed. Noguchi discloses *a method for responding to an electronic message comprising: presenting a main message with at least one option* (Noguchi teaches the main message being the system menu being presented to the user through the integrated receiver/decoder (IRD), [see Noguchi, Col. 8, lines 25-67 and Col. 9, lines 1-33]; *determining whether the at least one option was*

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selected [see Noguchi, Col. 8, lines 44-67]; *presenting information related to the selected option* (Noguchi teaches that once the main menu message is presented and then selected, there are several options that are displayed including and electronic message option), [see Noguchi, Figures 12A and 12B, Col. 8, lines 62-67, Col. 9, lines 1-33]. However, Noguchi does not explicitly disclose determining whether the selected option is to be transmitted.

10. In the same field of endeavor, Hashimoto discloses (e.g., a TV Mail System). Hashimoto discloses *determining whether the selected option is to be transmitted* [see Hashimoto, Figures 51, 52, 53, Col. 20, lines 42-67 and Col. 21, lines 1-65].

11. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Hashimoto's teachings of a TV Mail System with the teachings of Noguchi, for the purpose of widening the use of home-use television to a field for sending and receiving electronic mail [see Hashimoto, Col. 5, lines 25-27]. By this rationale **claim 1** is rejected.

12. Regarding **claim 2**, Noguchi-Hashimoto further discloses *wherein the at least one option is selected by using a remote control device* [see Noguchi, Figure 1, item 5]. By this rationale **claim 2** is rejected.

13. Regarding **claim 3**, Noguchi-Hashimoto further discloses *at least one option is selected by selecting a first number on a remote control device, wherein the first number corresponds to a second number related to the at least one option* (Noguchi teaches the selection of the system menu (option 9), that leads you to select another option (option 4)), [see Noguchi, Figure 12A, option 9, Figure 12B, option 4, Col. 8, lines 43-67, Col. 9, lines 1-34]. By this rationale **claim 3** is rejected.

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14. Regarding **claim 4**, Noguchi-Hashimoto further discloses *wherein an electronic message identifying the selected option is automatically generated to be sent if the selected option is determined to be transmitted* [see rejection of claim 1, supra]. By this rationale **claim 4** is rejected.

15. Regarding **claim 5**, Noguchi-Hashimoto further discloses *wherein the electronic message is unalterable by a user* (The Examiner takes **Official Notice** is taken (see MPEP 2144.03)), (It would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have provided for an electronic message that is unalterable by a user, and since Hashimoto does provide the motivation to utilize such a provision within an electronic message by including a inhibition flag for printing. Which one of ordinary skill would be able to include as a flag prohibiting altering of an electronic message). By this rationale **claim 5** is rejected.

16. Regarding **claim 6**, Noguchi-Hashimoto further discloses *determining whether a second option has been selected if it is determined that the selected option is not to be transmitted* [see rejection of claim 1, supra]. By this rationale **claim 6** is rejected.

17. Regarding **claim 7**, Noguchi-Hashimoto further discloses *wherein the second option is selected by selecting a key on a remote control device wherein the key corresponds to the second option* (Noguchi teaches the selection of the system menu (option 9), that leads you to select another option (option 4)), [see Noguchi, Figure 12A, option 9, Figure 12B, option 4, Col. 8, lines 43-67, Col. 9, lines 1-34]. By this rationale **claim 7** is rejected.

18. Regarding **claim 8**, Noguchi-Hashimoto further discloses *wherein the key represents a number corresponding to a number associated with the second option* [see rejection of claim 7, supra]. By this rationale **claim 8** is rejected.

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19. Regarding **claim 9**, Noguchi-Hashimoto further discloses *wherein the selected option is identified in a header of a message if the selected option is to be transmitted* [see Hashimoto, Figure 48]. By this rationale **claim 9** is rejected.

20. Regarding **claim 10**, Noguchi-Hashimoto further discloses *a method for sending an electronic message comprising: providing a main message; providing at least one option* [see rejection of claim 1, supra]; *providing information related to the at least one option, wherein the information is to be presented after the at least one option has been presented and after the at least one option has been selected; and transmitting the electronic message* [see rejection of claim 1, supra]. By this rationale **claim 10** is rejected.

21. Regarding **claim 11**, Noguchi-Hashimoto further discloses *wherein the at least one option is to be selected by using a remote control device* [see rejection of claim 2, supra]. By this rationale **claim 11** is rejected.

22. Regarding **claim 12**, Noguchi-Hashimoto further discloses *wherein the at least one option is to be selected by selecting a first number on a remote control device, wherein the first number corresponds to a second number related to the at least one option* [see rejection of claim 3, supra]. By this rationale **claim 12** is rejected.

23. Regarding **claim 13**, Noguchi-Hashimoto further discloses *wherein the at least one option is to be identified in an automatically generated reply message if the at least one option is selected* [see Hashimoto, Figure 47]. By this rationale **claim 13** is rejected.

24. Regarding **claim 14**, Noguchi-Hashimoto further discloses *wherein the selected option is identified in a header of the reply message if the selected option is to be transmitted* [see Hashimoto, Figure 48]. By this rationale **claim 14** is rejected.

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25. **Claim 15** is substantially the same as claim 5 and is thus rejected based upon similar rationale in rejected as applied to claims 4 and 5. By this rationale **claim 15** is rejected.

26. **Claims 16 and 17** list all the same elements of **claims 1 and 10**, but in system form rather than method form. Therefore, the supporting rationale of the rejection to **claims 1 and 10** applies equally as well to **claims 16 and 17**. It would have been also obvious to one ordinary skill in the networking art at the time the invention was made to have utilized a system for carrying for implementing the method instructions.

27. **Claims 18 and 19** lists all the same elements of **claims 1, 10 and 16**, but in computer program product form rather than method and system program product form. Therefore, the supporting rationale of the rejection to **claims 1, 10 and 16** applies equally as well to **claims 18 and 19**. It would have been also obvious to one ordinary skill in the networking art at the time the invention was made to have utilized a method for carrying out the instruction for use within an apparatus. With regards to the *computer readable medium being selected from the group consisting of CD-ROM, floppy disk, tape, flash memory, system memory, hard drive, and data signal embodied in a carrier wave* (The Examiner takes **Official Notice** is taken (see MPEP 2144.03)), see prior art of record Kikinis et al., U.S. Patent No. 5,522,089, Col. 16, lines 60-66, Col. 20, lines 26-37). By this rationale **claims 18 and 19** are rejected.

Conclusion

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-5:00, 1st Friday Off.

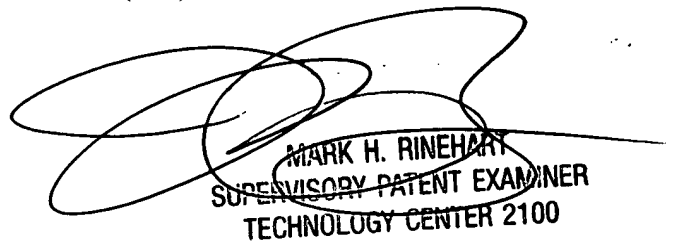
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

WCV

WCV
Patent Examiner
Art Unit 2152
August 29, 2002


MARK H. RINEHART
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100